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REMARKS

Claims 1-48 are currently pending in the subject application and are presently under consideration. A listing of all the pending claims is found at pages 2-9. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1-40, 42 and 45-48 Under 35 U.S.C. §102(b)**

Claims 1-40, 42 and 45-48 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jones, *et al.* (U.S. 5,666,501). Withdrawal of this rejection is respectfully requested for at least the following reasons. Jones, *et al.* does not disclose or suggest each and every limitation set forth in the subject claims.

*A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).*

The claimed invention relates to a software tool and methodology for installing a software component or an operating system on a server computer system or computer network. In particular, independent claims 1, 14, 21, 28, 35, 39 and 40 recite similar limitations, namely *a setup component that senses an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, selectively provides at least one setup prompt to the user interface component according to the attribute, and selectively installs the software component on the computer system according to the user command.* Jones, *et al.* does not disclose or suggest these novel aspects of applicants' claimed invention.

Jones, *et al.* relates to a method for installing software from a second machine to a first machine in a distributed network. The Examiner contends that the novel aspects of the invention as claimed are disclosed at col. 2, lines 7-12, col. 3, lines 28-37 and col. 3, line 59-col. 4, line 15,

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of the cited document. Applicants' representative respectfully disagrees. Jones, *et al.*, at col. 2, lines 7-12, provides that if a software bundle of objects is selected, the method disclosed by the cited document proceeds to install an intersection of the software items of the source object and the software items of the selected bundle object. Col. 3, lines 28-37, further provides that each bundle of software can contain a list of software items embodied as a subset of the selected source object and additionally, that each software bundle can contain installable software items located on separate source objects. Consequently, according to the cited passage, depending on whether all the software items listed in a bundle are available in the particular source object, a given bundle can be either a subset or a superset of that particular source object. In addition, col. 3, line 59-col. 4, line 15, discloses that display controls allow a user to control and manipulate the contents of a panel wherein the user can apply controls to a single item in the panel, highlight or select items in the panel, or select all the items in the panel. Further, the noted passage provides that a first display control can be used to expand the items in the panel to show available product options, a second display control can be employed to sort the contents of the panel by type, date, name, or any other attribute, and a third display control can be utilized to search the contents of the panel based on type, date, name, or any other attribute. However, nowhere in the cited document is it disclosed or suggested that a registry of a server is ever accessed let alone sensed. Applicants' claimed invention in contrast, senses an attribute of a registry of the server computer system, wherein the sensed attribute is associated with a low functionality suite package and a higher functionality suite package. The sensed attribute is then utilized by a setup component to selectively provide at least one setup prompt to a user interface component based on the sensed attribute. The setup component then, in response to the user's command, selectively installs the software component on the computer system.

The Examiner further asserts that it is inherent that a setup component is adapted to sense an attribute of a registry associated with a computer system. Applicants' representative avers to the contrary. It is submitted that inherency cannot be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Rather, to demonstrate inherency, *the cited document* must show that the natural result flowing from an operation *as taught* would result in the performance of the questioned function. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (emphasis added). This, the Examiner has been unable to do. How, it is conjectured, is it possible for a setup component to

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be adapted to sense an attribute of a registry associated with a computer system when the cited document itself does not disclose or suggest the utilization of registries? Thus, it is submitted that without a showing by the Examiner that the cited document makes at least a fleeting reference to a registry or its equivalent, that no inherency whatsoever can be gleaned from Jones, *et al.*

Additionally, the Examiner is reminded that the standard by which anticipation is to be measured is *strict identity* between the cited document and the invention as claimed, not mere equivalence or similarity. *See, Richardson* at 9 USPQ2d 1913, 1920. This means that in order to establish anticipation under 35 U.S.C. §102, the single document cited must not only expressly or inherently describe each and every limitation set forth in the patent claim, but also the identical invention must be shown in as complete detail as is contained in the claim. As stated *supra*, Jones, *et al.* is deficient in failing to provide a registry, or for the utilization of a registry, in fact the cited document is silent regarding this salient feature of the invention as claimed. It is thus evident that Jones, *et al.* does not disclose an invention identical to that recited in the subject claims.

In view of at least the foregoing, it is readily apparent that Jones, *et al.* does not show the identical invention in as complete detail as is contained in the subject claims. Accordingly it is respectfully requested that this rejection with respect to independent claims 1, 14, 21, 28, 35, 39 and 40 (and claims that depend there from) should be withdrawn.

## II. Rejection of Claims 41, 43 and 44 Under 35 U.S.C. §103(a)

Claims 41, 43 and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jones, *et al.* (U.S. 5,666,501) in view of Kenner, *et al.* (U.S. 6,314,565). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claims 41, 43 and 44 depend from independent claim 40. Kenner, *et al.* does not make up for the aforementioned deficiencies of Jones, *et al.* with respect to independent claim 40. Thus, the subject invention recited in independent claim 40 (and claims 41, 43 and 44 depending therefrom) is not obvious over Jones, *et al.* in view of Kenner, *et al.* Accordingly, this rejection be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP169US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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